



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appeal Brief Transmittal

AF/2683
#

In re: Application of: Bates, *et al.*

Serial No.: 09/759,784

Filed on: 01/12/01

For: **TELEPHONE SYSTEM AND METHOD FOR SELECTIVELY RINGING ONE OR MORE
LAND PHONES OR PORTABLE PHONES BASED ON THE SELF-DETECTED
GEOGRAPHICAL POSITION OF A PORTABLE PHONE**

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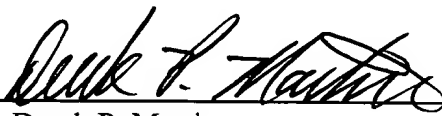
Sir:

Transmitted herewith for filing is an **Appeal Brief** in triplicate for the above-identified Application.

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Respectfully submitted,

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Date: June 21, 2004

By: 



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Bates, *et al.* Docket No.: ROC920000007US2
Serial No.: 09/759,784 Group Art Unit: 2683
Filed: 01/12/01 Examiner: D AGOSTA, STEPHEN M.
For: TELEPHONE SYSTEM AND METHOD FOR SELECTIVELY RINGING ONE OR
MORE LAND PHONES OR PORTABLE PHONES BASED ON THE
SELF-DETECTED GEOGRAPHICAL POSITION OF A PORTABLE PHONE

APPEAL BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

This appeal is taken from the Examiner's final rejection, set forth in the Office Action dated 01/20/04, of applicants' claims 1-22 and 26. Applicants' Notice of Appeal under 37 C.F.R. § 1.191 was mailed on 04/20/04.

REAL PARTY IN INTEREST

International Business Machines Corporation is the Real Party in Interest.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences for this patent application or its parent.

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STATUS OF CLAIMS

Claims 1-26 were originally filed in this continuation-in-part patent application. In response to the first office action dated 09/18/03, an amendment was filed on 12/16/03 that canceled claims 23-25 and amended claims 1 and 10. In the pending final office action, claims 1, 5-6, 10 and 13-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,903,833 to Jonsson *et al.* (hereinafter "Jonsson") in view of U.S. Patent No. 5,502,762 to Andrew *et al.* (hereinafter "Andrew"). Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Jonsson in view of U.S. Patent No. 5,235,633 to Dennison *et al.* (hereinafter "Dennison"). Claims 3, 8-9, 11 and 16-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jonsson in view of U.S. Patent No. 6,405,041 to Mukerjee *et al.* (hereinafter "Mukerjee"). Claims 4 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jonsson and further in view of DeBrito. Claims 7 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jonsson and further in view of U.S. Patent No. 6,038,451 to Syed *et al.* (hereinafter "Syed"). Claims 18 and 20-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jonsson and further in view of Hardouin. Claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over Jonsson in view of Dennison. Claim 26 was rejected under 35 U.S.C. §103(a) as being unpatentable over Jonsson in view of U.S. Patent No. 6,459,695 to Schmitt. No claim was allowed. Claims 1-22 and 26 are currently pending, all of which stand finally rejected.

STATUS OF AMENDMENTS

The amendment filed on 12/16/03 in response to the first office action has been entered. Therefore, the claims at issue in this appeal are the claims as amended by the amendment filed on 12/16/03.

SUMMARY OF INVENTION

A portable phone is equipped with a position detector that detects the geographical position of the portable phone, and a telephone system may ring one or more land-based phones or portable phones according to the geographical position of the portable phone. One or more geographical regions are defined, with corresponding telephone parameters defined for each region. When a portable phone enters a defined region, exits a defined region, or changes between two defined regions, the function of one or more land-based phones or portable phones may change. The preferred embodiments thus allow changing the function of one or more other phones based on the self-detected geographical position of a portable phone. In this manner the convenience of using portable phones is greatly enhanced.

ISSUES

The following issues are presented for review on this Appeal:

- 1. Whether claims 1, 5-6, 10 and 13-14 are unpatentable under 35 U.S.C. §103(a) over Jonsson in view of Andrew**
- 2. Whether claim 2 is unpatentable under 35 U.S.C. §103(a) over Jonsson in view of Dennison**
- 3. Whether claims 3, 8-9, 11 and 16-17 are unpatentable under 35 U.S.C. §103(a) over Jonsson in view of Mukerjee**
- 4. Whether claims 4 and 12 are unpatentable under 35 U.S.C. §103(a) over Jonsson in view of DeBrito**

5. **Whether claims 7 and 15 are unpatentable under 35 U.S.C. §103(a) over Jonsson in view of Syed**
6. **Whether claims 18 and 20-22 are unpatentable under 35 U.S.C. §103(a) over Jonsson in view of Hardouin**
7. **Whether claim 19 is unpatentable under 35 U.S.C. §103(a) over Jonsson in view of Dennison**
8. **Whether claim 26 is unpatentable under 35 U.S.C. §103(a) over Jonsson in view of Schmitt**

GROUPING OF CLAIMS

Claims 1, 2, 4-7, 10, and 12-15 are grouped, and stand and fall together based on claim 1. Claims 3 and 11 are grouped, and stand and fall together based on claim 3. Claims 8, 9, 16 and 17 are grouped, and stand and fall together based on claim 8. Claims 18, 19 and 21 are grouped, and stand and fall together based on claim 18. It is applicants' intention that the patentability, *vel non*, of claims 20, 22 and 26 be considered independently, as these claims do not stand or fall with any other claim. Each of claims 20, 22 and 26 are properly considered independently from any other claim because each has a scope that is different than all other claims.

ARGUMENT

Issue 1: Whether claims 1, 5-6, 10 and 13-14 are unpatentable under 35 U.S.C. §103(a) over Jonsson in view of Andrew

Claim 1

In the final office action, the Examiner rejected claims 1, 5-6, 10 and 13-14 under 35 U.S.C. §103(a) as being unpatentable over Jonsson in view of Andrew. Claim 1 states:

1. A telephone system comprising:
 - a portable phone that includes a position detector that detects the position of the portable phone;
 - a second phone; and
 - a call router that automatically rings the second phone without requiring input from a user of the portable phone when a call is received for the portable phone if the portable phone is within a predetermined physical relationship with the second phone as indicated by the position detector in the portable phone.

In the rejection, the Examiner states that Jonsson teaches a portable phone that includes a position detector that detects the position of the portable phone. Applicants respectfully assert that the detector in the portable phone in Jonsson does not detect the absolute position of the portable phone, but merely detects proximity to low energy registration devices. The Abstract of Jonsson at lines 7-9 states: "As the mobile terminal enters the coverage area of a registration device, the mobile telephone receives a registration signal from the registration device." The control module 26 thus detects *proximity* to a registration device 24, but this is not the same thing as **position**. If we assume the registration device taught in Jonsson is a low energy omni-directional transmitter, the coverage of the registration device would be a spherical field. Whenever a mobile telephone in Jonsson enters the spherical field, the control module

26 would detect the transmission from the registration device 24, allowing the control module to know it is within the spherical field of that registration device 24. This does not tell the control module the *position* of the mobile device within the spherical field. If we assume the registration device radiates its signal in a 15-foot spherical pattern, when the control module 26 detects the transmission from the registration device 24, it has no idea its position relative to the registration device 24. The only information that control module 26 may infer is that control module 26 is within the 15 foot spherical field surrounding the registration device 24. The control module 26 has no idea whether it is located to the North, South, East or West, or up one floor or down one floor from the registration device 24. Furthermore, once the control module 26 is within the detection zone of the registration device, the control module 26 may be moved to other positions that are still within the detection zone of the registration device, and the Jonsson system will have no idea regarding this change of position. Thus, the control module 26 in Jonsson does not read on the position detector in claim 1 “that detects the position of the portable phone.” Detecting proximity to a registration device is not the same thing as detecting *position* of the portable phone, as recited in claim 1. Because Jonsson does not detect the *position* of the portable phone, claim 1 is allowable over the combination of Jonsson and Andrew.

In rejecting claim 1, the Examiner states that Jonsson is silent on automating the router to ring the second line without input from the user. The Examiner then cites to Andrew as teaching a phone system that automatically redirects an incoming call for a first line to a selected one or more second lines. The Examiner then concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jonsson, such that the system in Jonsson automatically routes calls without user input, to provide an automated system that provides ease-of-use to the user so they do not have to decide which phone to ring. Applicants respectfully assert that Jonsson expressly teaches away from the cited features in Andrew, and that Andrew expressly teaches away from the cited features in Jonsson, making the combination of Jonsson

and Andrew improper under 35 U.S.C. §103(a). To understand the reasons that Jonsson and Andrew cannot be combined as suggested by the Examiner, we now look at the detailed teachings of both.

The title of Jonsson is "METHOD AND APPARATUS FOR ROUTING CALLS BY REMOTE CONTROL." Then entire disclosure of Jonsson is directed to a system where a user, using a mobile telephone, can decide where to route a telephone call. This is clear in the Abstract at lines 1-3 and 8-15; steps 468 and 470 of FIG. 11; steps 512 and 514 in FIG. 12; steps 566 and 568 in FIG. 13; col. 1 lines 7-10; col. 2 lines 28-31, lines 32-34, and lines 41-43; col. 4 lines 1-4 ("routing calls by remote control"); col. 5 lines 1-3, lines 15-18, and lines 52-53; col. 6 lines 11-12; col. 7 lines 5-10, lines 23-27, and lines 65-67; col. 9 lines 33-34; col 10 line 28 and line 67 ("remotely controlled call routing system"); col. 11 lines 33-34 and lines 61-63; col. 12 lines 39-41, and lines 56-58; col. 13 lines 25-27; and col. 14 line 5 ("method for remote control of routing a call"), and lines 25-29. While this list of references may appear extensive, they are but a representative group of references in Jonsson that expressly teach that the user in Jonsson makes a selection on a mobile phone to route a call by remote control. The entire disclosure in Jonsson, and even the title itself, expressly teach user intervention for routing a call by remote control. Nowhere does Jonsson teach or suggest that a call may be routed automatically. To the contrary, the entire goal of Jonsson is to allow a user to route a call by remote control using a mobile phone.

In the rejection, the Examiner states:

Andrew teaches a phone system (automatically) redirecting an incoming call for a first line to a selected one or more second lines (abstract).

It would have been obvious to one skilled in the art at the time of the invention to modify Jonsson, such that the system automatically

routes calls without user input, to provide an automated system that provides ease-of-use to the user so that they do not have to decide which phone to ring.

In essence the Examiner states that it would have been obvious to modify Jonsson in a way that violates all of its express teachings regarding remote control of a call. The entire purpose of Jonsson is to allow a user to remotely control the routing of a call. To say that automatic routing of a call would be obvious goes against all of the express teachings of Jonsson. For this reason, the proposed combination of Jonsson and Andrew is improper.

The call router in Jonsson resides within the service node 14 of the telephone network shown in FIG. 1. While Andrew teaches a call router, this call router is not in the telephone network. Instead, the call router 10 in Andrew is located between the telephone network 12 and a telephone 16. Andrew discusses in the Background of the Invention section that the function of ringing two phones could be implemented in the telephone switching network, but lists many reasons why it is undesirable to do so. See col. 1 lines 41-67 of Andrew. The Andrew invention solves the problems associated with incorporating the function of ringing multiple phones in the telephone switching network by performing the ringing of multiple phones in a separate device 10 that is interposed between the telephone switching network 12 and the user's telephone 16. Andrew thus expressly teaches away from incorporating its function into the telephone switching network. Yet, according to the Examiner, the combination of Jonsson and Andrew does just that: it provides the function of Andrew into the call router in Jonsson, which is a telephone switching network, against the express teachings of Andrew that state the undesirability of implementing the Andrew invention in the telephone switching network.

We see from this simple analysis above that Jonsson teaches away from automatically routing a call without user intervention. To the contrary, the whole purpose and intent of Jonsson is to allow a user to route a call by remote control. In addition, Andrew expressly teaches away from incorporating its functions into a telephone switching network, as suggested by the Examiner. For these reasons, the combination of Jonsson and Andrew is improper.

In the "Response to Arguments" section of the pending office action, the Examiner attempts to defend his rejection of claim 1 by stating: "If Jonsson's invention were placed in a situation where there is only one other phone (eg., the second phone), the system would only be capable of ringing the second phone which would be automated." This statement is erroneous in view of the express teachings of Jonsson. Even if only one other phone is provided in Jonsson, the user still has to select whether the call is routed to the mobile phone or to the other phone. This is shown at steps 460, 462, 468 and 470 of FIG. 11 of Jonsson. Thus, the Examiner's assertion that Jonsson's invention would function as taught in claim 1 with only one second phone is in error given the express teachings of Jonsson. The primary intent and main function and advantage provided by Jonsson is the ability of a user to remotely control via a mobile phone where a call is routed. Automatic routing of a call goes against this primary intent and main function of Jonsson, and would therefore not have been obvious to one of ordinary skill in the art.

The Examiner appears to be treating the prior art as a smorgasbord, where he can pick and choose whatever teachings he likes out of a given reference without regard to the remaining teachings of the reference. Applicants strenuously assert that this approach is improper. The propriety of the combination must be measured by the express teachings of the references. If a reference expressly teaches away from a given function, that function cannot be obvious in light of the reference. Thus, it is improper to say that one of ordinary skill in the art would be motivated to automate the call

routing of Jonsson so that it occurs without user intervention, when the entire disclosure of Jonsson is directed to call routing by remote control by a user. Likewise, it is also improper to say that one of ordinary skill in the art would be motivated to provide the functions of Andrew in a telephone switching network when Andrew expressly teaches away from this implementation. It cannot be obvious to combine references in a way that is repugnant to the express teachings of the references themselves. For this reason, the combination of Jonsson and Andrew is improper. Because the combination is improper, claim 1 is allowable over the cited art. Applicants respectfully request that the Examiner's rejection of claim 1 under 35 U.S.C. §103(a) be reversed.

Claims 5, 6, 10, 13 and 14

Claims 5, 6, 10, 13 and 14 are grouped with claim 1, and stand or fall according to the allowability of claim 1.

Issue 2: Whether claim 2 is unpatentable under 35 U.S.C. §103(a) over Jonsson in view of Dennison

Claim 2 is grouped with claim 1, and stands and falls according to the allowability of claim 1.

Issue 3: Whether claims 3, 8-9, 11 and 16-17 are unpatentable under 35 U.S.C. §103(a) over Jonsson in view of Mukerjee

Claim 3

The arguments above with respect to claim 1 apply equally to claim 3, and are incorporated in this section by reference. The Examiner rejected claims 3, 8-9, 11 and

16-17 under 35 U.S.C. §103(a) as being unpatentable over Jonsson in view of Mukerjee. In the rejection of claims 3 and 11, the Examiner correctly states: “Jonsson teaches a manual user selection (via the mobile phone) as to which phone is to be used.” The Examiner then cites to Mukerjee as teaching simultaneously ringing a subscriber’s wired and wireless phones simultaneously, and concludes:

It would have been obvious to one skilled in the art at the time of the invention to modify Jonsson [sic], such that both phones are rung until one is answered, to provide means for the user to select which phone they want to answer.

Applicants respectfully assert that one of ordinary skill in the art would not be motivated to combine Jonsson and Mukerjee as suggested by the Examiner because their teachings are incompatible. Furthermore, the Examiner’s rationale for the combination is defective.

In Jonsson, when a call is received, a user is notified on the mobile terminal, and a list of fixed telephones in proximity to the mobile terminal are displayed on the display of the mobile terminal. The user selects ONE of these phones, and in response to the selection, the call is routed to this ONE selected phone. While Mukerjee teaches ringing two phones simultaneously, the user-selection capability of Jonsson allows the user to select a single phone, not multiple phones. Because Jonsson expressly teaches selecting a single phone, Jonsson expressly teaches away from ringing multiple phones. For this reason, the combination of Jonsson and Mukerjee as suggested by the Examiner would not have been obvious to one of ordinary skill in the art at the time of the invention.

In addition, the Examiner’s stated rationale for combining Jonsson and Mukerjee is defective. The Examiner states the combination would have been obvious “to provide means for the user to select which phone they want to answer.” This rationale is defective because Jonsson alone provides means for the user to select which phone they want to answer via the user interface on the mobile terminal. Mukerjee is not needed to

provide such a means, so the Examiner's stated rationale for combining Jonsson and Mukerjee is defective. As a result, the Examiner has failed to establish a prima facie case of obviousness under 35 U.S.C. §103(a) for claim 3.

In the Response to Arguments section of the pending office action, the Examiner attempts to justify the rejection of claim 3 by stating:

... if a user is in a hallway when a call is received and wants to transfer the call, they may not know where each nearby phone is and will want to ring multiple phones and select the closest one (which provides motivation for ringing multiple phones and selecting which one to answer).

Mukerjee clearly teaches ringing a land line and a mobile phone at the same time when a call is made to either of the two. Jonsson, in contrast, allows the user to remotely control the routing of a call by making an appropriate selection on the mobile phone to determine which ONE PHONE the call is routed to. The Examiner attempts to justify this weak rejection with a contrived scenario that would not be desirable or obvious in a normal office environment.

Let's assume the Jonsson invention is used in a busy office. In most busy offices, many phones ring at various times. The Examiner states, based on his contrived example, that it would be desirable for a user to ring multiple phones and select the closest one by listening for the ring. There's two big problems with this assertion. First, Jonsson is devoid of any teaching regarding the ringing of multiple phones. Jonsson is concerned with routing a call to a SINGLE PHONE. In order to ring multiple phones at the same time, the call must be routed to multiple phones at the same time. The system in Jonsson simply does not have this capability, express or inherent. When a call is received by the Jonsson system, the user must quickly select to which phone to route the call. If the user were to take the time to select multiple other phones, then listen for the ring of the closest phone, the locate and answer the closest phone, the caller would have to wait an unacceptable number of rings before the call could be answered. Furthermore, even if the

user could somehow select multiple phones and even if the Jonsson system could ring multiple other phones simultaneously, this would not be a desired function of the Jonsson system. The system in Jonsson assumes the user knows the location of the other phones. If the user selects multiple phones, and the call is routed to all those multiple phones at the same time, as suggested by the Examiner, how would the user be able to distinguish between the ring on a phone that represents his call and the ring on a phone that represents some other caller? The user might stop at the first ringing phone and pick it up, only to find out they have answered a new incoming call instead of their desired call. Meanwhile, the other (desired) call will keep ringing on the other phones. This scenario is not realistic or desirable in the environments where telephone systems are in common use today. Furthermore, if the user in Jonsson does not know the location of the other phones, the user can always just answer the call on the mobile phone, which eliminates the need to listen and try to find the ringing phone. The Examiner's contrived example is simply that, contrived, and does not represent a real need in the art that would motivate one of ordinary skill in the art to combine the teachings of Jonsson and Mukerjee as suggested by the Examiner.

Because Jonsson teaches a user selecting a single phone and routing a call to the single user-selected phone, it would not have been obvious to apply the teachings of Mukerjee regarding simultaneously ringing multiple phones to Jonsson. As a result, claim 3 is allowable over the combination of Jonsson and Mukerjee. In addition, claim 3 depends on claim 1, which is allowable for the reasons given above. As a result, claim 3 is also allowable as depending on an allowable independent claim. Applicants respectfully request that the Examiner's rejection of claim 3 under 35 U.S.C. §103(a) be reversed.

Claim 11

Claim 11 is grouped with claim 3, and stands and falls according to the allowability of claim 3.

Claim 8

The arguments above with respect to claims 1 and 3 apply equally to claim 8, and are incorporated in this section by reference. In rejecting claim 8, the Examiner admits that Jonsson does not teach the call router further rings the portable phone when a call is received for the second phone if the portable phone is within the predetermined physical relationship with the second phone. However, in the very next paragraph at the top of p. 6 of the office action, the Examiner states:

Jonsson teaches allowing the mobile or the fixed phone to receive or make a call based upon the mobile's phone number, the fixed phone number or the mobile using a newly assigned fixed phone number. This would provide for the mobile phone to ring if the second phone receives a call. Also reference C12, L44-54.

The Examiner's rejection is unclear. In one sentence, the Examiner states that Jonsson is silent on the limitations of claim 8. Then in the very next paragraph, the Examiner cites to teachings of Jonsson that allegedly read on these limitations. Because the Examiner has not clearly laid out his case for rejecting claim 8, the Examiner has failed to establish a prima facie case of obviousness for claim 8 under 35 U.S.C. §103(a).

Applicants respectfully assert that the Examiner has mischaracterized Jonsson in the rejection language quoted above. Jonsson does not teach "allowing a mobile or the fixed phone to receive or make a call based upon the mobile's phone number, the fixed phone number or the mobile using a newly assigned fixed phone number", as stated by the Examiner. The cited portion of Jonsson at col. 12 lines 44-54 teaches a way for a user

to initiate a call on a mobile phone, then select another phone, which rings, allowing the call to be placed via the other phone instead of via the mobile phone. This, however, has no bearing on the limitations in claim 8 of “ringing the portable phone when a call is received for the second phone if the portable phone is within the predetermined physical relationship with the second phone.” According to the express language of claim 8, the portable phone is rung “when a call is received for the second phone.” The “second phone” in Jonsson is one of the phones that the user may select for initiating or receiving a call. Thus, to read on claim 8, Jonsson would have to teach the ringing of the mobile phone when one of the “other” phones is called. There is no such teaching or suggestion in Jonsson. To the contrary, all of the calls in Jonsson are made via the mobile telephone network. The first three lines of the Jonsson Abstract reads: “A mobile telephone is used to control the routing of an incoming or outgoing call *in a mobile communications network.*” Claim 8, in contrast, recites the ringing of the portable phone when a call is received for the second phone. This implies that a call received by the telephone switching network is now being answered by the mobile phone. This is not possible in Jonsson.

The cited language in Jonsson relates to initiating a call using the mobile phone to possibly select a different phone for initiating the call. In this scenario, if the user selects a different phone for initiating the call, the different phone rings. When the user picks up the ringing phone, the call is initiated via the answered phone. At no point during this procedure does the mobile phone ring.

Jonsson is devoid of any teaching or suggestion of ringing the mobile phone when a call is received for a second phone. The Examiner cites to Mukerjee as teaching simultaneous ringing of a subscriber’s wired and wireless phones. Applicants respectfully assert that the combination of Jonsson and Mukerjee suggested by the Examiner is improper for the many reasons given above in the discussion of claim 3. Thus, claim 8 is allowable for the same reasons given above with respect to claim 3. In

addition, claim 8 depends on claim 1, which is allowable for the reasons given above. As a result, claim 8 is also allowable as depending on an allowable independent claim. Applicants respectfully request that the Examiner's rejection of claim 8 under 35 U.S.C. §103(a) be reversed.

Claims 9, 16 and 17

Claims 9, 16 and 17 are grouped with claim 8, and stand and fall according to the allowability of claim 8.

Issue 4: Whether claims 4 and 12 are unpatentable under 35 U.S.C. §103(a) over Jonsson in view of DeBrito

Claims 4 and 12 are grouped with claim 1, and stand and fall according to the allowability of claim 1.

Issue 5: Whether claims 7 and 15 are unpatentable under 35 U.S.C. §103(a) over Jonsson in view of Syed

Claims 7 and 15 are grouped with claim 1, and stand and fall according to the allowability of claim 1.

Issue 6: Whether claims 18 and 20-22 are unpatentable under 35 U.S.C. §103(a) over Jonsson in view of Hardouin

The Examiner rejected claims 18 and 20-22 under 35 U.S.C. §103(a) as being unpatentable over Jonsson and further in view of Hardouin. Each of these claims is addressed below.

Claim 18

The arguments above with respect to claims 1, 3, and 8 apply equally to claim 18, and are incorporated in this section by reference. In the rejection, the Examiner recites claim language that is not found in claim 18. It appears the Examiner has cut-and-pasted part of his rejection of claim 1, and in so doing has failed to address the proper limitations expressly recited in claim 18. For example, the Examiner states that Jonsson teaches a second phone. A second phone is not found in claim 18. Furthermore, the Examiner states that Jonsson teaches a “call router that rings the second phone when a call is received for the portable phone if the portable phone is within a predetermine physical relationship with the second phone as indicated by the position detector in the portable phone.” This language is not found in claim 18, but is the language found in claim 1 prior to being amended in response to the first office action. Claim 18, in contrast, recites: “a call router that rings and routes a telephone call according to the phone parameters for a region.” The Examiner has not addressed this limitation in his rejection. In addition, nowhere in the rejection does the Examiner address limitation (C) in claim 18. Because the Examiner has completely failed to address either of limitations (C) or (D) in claim 18, the Examiner has failed to establish a prima facie case of obviousness for claim 18 under 35 U.S.C. §103(a).

In rejecting claim 18, the Examiner states that Jonsson:

is silent on each geographical region having a phone parameter that determines how a call is run and routing a call based on the phone parameters for a region.

The Examiner then cites to Hardouin’s teaching of audio/vibrating alerting based on location on these limitations in the claims. Applicants respectfully assert that the Examiner has not considered the interrelationship between limitations in claim 18.

Claim 18 recites a combination of two limitations (B) and (D) that need to be read together. These limitations state:

(B) at least one defined geographical region, each defined geographical region having corresponding phone parameters that determine how a call is rung and routed; . . .

(D) a call router that rings and routes a telephone call according to the phone parameters for a region.

Hardouin teaches a plurality of geographical regions that have audio parameters that determine how a call is rung. The parameters in Hardouin are shown in FIG. 2 to include ringer volume, audio out volume, and audio in volume. These parameters, however, do not determine how a call is routed. These parameters only affect the function of a phone in a defined geographical region once a call is already routed to the phone. In Hardouin, there is no teaching or suggestion that a call may be routed differently depending on phone parameters for a geographical region. For this reason, Hardouin does not read on limitation (B) which includes phone parameters that determine how a call is rung *and routed*.

Limitation (D) in claim 18 recites a call router that rings and routes a telephone call according to the phone parameters for the region. Hardouin has no such call router. In Hardouin, when a telephone enters a defined geographical region, it inherits the audio parameters for that region that determine how the phone is rung and volume level for the incoming and outgoing audio. In Hardouin, a call to a mobile phone is simply routed to the mobile phone. The way the mobile phone rings and the audio settings for the mobile phone are set by the parameters that the phone inherits from the geographical region when it enters the region. No function regarding ringing and routing is performed by a call router in Hardouin. As a result, Hardouin has no teaching or suggestion of the call router in limitation (D) in claim 18. As a result, claim 18 is allowable over the combination of

Jonsson and Hardouin, and applicants respectfully request that the Examiner's rejection of claim 18 under 35 U.S.C. §103(a) be reversed.

Claim 20

The arguments above with respect to claims 1, 3, 8 and 18 apply equally to claim 20, and are incorporated in this section by reference. In rejecting claim 20, the Examiner stated that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jonsson such that geographical location information as taught in Hardouin is provided in the phone. This assertion, however, goes against the express teachings of Hardouin. In Hardouin, audio parameters are assigned to geographical regions. When a mobile phone enters a geographical region, the mobile phone inherits the audio parameters assigned to the region. The whole purpose of Hardouin is to provide a system-level definition (not in the mobile phone) that the mobile phones can inherit when they enter a defined region. To say that one of ordinary skill in the art would modify Jonsson to provide the geographical location information in Hardouin within the phone itself ignores the express teachings of Hardouin that teach away from such a modification.

It is interesting to compare the limitations of claims 20 and 21. Claim 20 recites that the geographical region in (B) and the mechanism in (C) reside within the portable phone, while claim 21 recites that these features reside in a telephone company network coupled to the portable phone. Yet the Examiner uses the same combination of Jonsson and Hardouin to reject both of claims 20 and 21. It is impossible for the same combination to read on both of these claims, absent some express teaching or suggestion in the art. There is no such teaching or suggestion. This blanket application of the combination of Jonsson and Hardouin to both of claims 20 and 21 shows that the Examiner has not properly addressed the limitations in these claims.

For the many reasons given above, claim 20 is allowable over the combination of Jonsson and Hardouin. In addition, claim 20 depends on claim 18, which is allowable for the reasons given above. As a result, claim 20 is also allowable as depending on an allowable independent claim. Applicants respectfully request that the Examiner's rejection of claim 20 under 35 U.S.C. §103(a) be reversed.

Claim 21

Claim 21 is grouped with claim 18, and stands and falls according to the allowability of claim 18.

Claim 22

The arguments above with respect to claims 1, 3, 8, 18 and 20 apply equally to claim 22, and are incorporated in this section by reference. In rejecting claim 22, the Examiner reads Hardouin as teaching the updating of phone parameters when exiting a region. Applicants respectfully assert that the Examiner has failed to address all limitations in claim 22, and has therefore failed to establish a prima facie case of obviousness for claim 22 under 35 U.S.C. §103(a).

Claim 22 includes the limitation at lines 6-7 of:

defining phone parameters that determine how a call is rung and routed for each defined geographical region;

Hardouin teaches defining phone parameters that determine how a call is rung for each defined geographical region. However, Hardouin does not teach phone parameters that determine how a call is routed for each defined geographical region. For this reason, claim 22 is allowable over the combination of Jonsson and Hardouin.

Claim 22 at lines 11-14 recites:

updating phone parameters for a geographical region when the portable phone enters the geographical region;
updating phone parameters for a geographical region when the portable phone exits the geographical region;

Nowhere does Hardouin teach or suggest that the phone parameters for a geographical region are updated as a phone enters and exits the geographical region. To the contrary, Hardouin teaches just the opposite. The audio parameters in Hardouin are defined for a geographical region. When a phone enters a geographical region, it inherits the audio parameters for that region. The audio parameters for a region are fixed, and do not change as phones enter or exit the region. When a call is routed to a phone in the region, the phone rings with audio input and output settings according to the audio parameters for the region that the phone inherited when it entered the region. The system in Hardouin thus expressly teaches away from updating phone parameters as a portable phone enters and exits the geographical region, as recited in claim 22. The phone parameters for each geographical region in claim 22 are updated as phones enter and exit the region. This is required so the call router knows which phone or phones to route the call to (and ring) when a call is received. In Hardouin, in contrast, the audio parameters for a defined geographical region are unaffected by phones entering and exiting the region because these phones automatically inherit the audio parameters for the region when they enter the region. The functions in Hardouin can be performed at the level of the mobile phone because the audio parameters only affect how an incoming call is rung and received. Hardouin thus teaches no function that affects the *routing* of calls according to phone parameters for a geographical region.

In the Response to Arguments section of the pending office action, the Examiner states: “The Examiner interprets basic operation and features as reading on routing a call (eg. if a user roams into an area outside their home area, do not allow incoming/outgoing

calls, etc.).” It is true that the Examiner can give claim terms their broadest reasonable interpretation. However, in this case, the Examiner has stretched the term “routing a call” way beyond its reasonable limits. The routing of a telephone call is very well-known and defined in the cited art. To state that changing parameters on a portable phone somehow reads on the routing of a call to that portable phone goes against the express teachings in the art concerning call routing. In the system of Hardouin, the function of the portable phone changes, but calls are not routed according to the phone parameters. In Hardouin, the call is always routed to the portable phone. The portable phone may decide whether to ring or vibrate, but the call is always routed to the portable phone. For this reason, the Examiner’s assertion that the basic operation and features of a portable phone in Hardouin reads on “phone parameters that determine how a call is run and routed” in claim 22 is in error. For the many reasons give above, claim 22 is allowable over the combination of Jonsson and Hardouin, and applicants respectfully request that the Examiner’s rejection of claim 22 under 35 U.S.C. §103(a) be reversed.

**Issue 7: Whether claim 19 is unpatentable under 35 U.S.C. §103(a) over
Jonsson in view of Dennison**

Claim 19 is grouped with claim 18, and stands and falls according to the allowability of claim 18.

**Issue 8: Whether claim 26 is unpatentable under 35 U.S.C. §103(a) over
Jonsson in view of Schmitt**

The Examiner rejected claim 26 under 35 U.S.C. §103(a) as being unpatentable over Jonsson in view of U.S. Patent No. 6,459,695 to Schmitt. In the rejection of claim 26, the Examiner admits that Jonsson is silent on limitations 1-5 in claim 26. The Examiner then cites to Schmitt as teaching a method that can identify a region within a geographic coverage of a base station in a wireless network and interpolate the locations

in said region to define a boundary of said region, citing claim 1 of Schmitt. Applicants readily admit that the Examiner's reading of Schmitt is very creative. But Schmitt does not read on the specific steps recited in claim 26.

Schmitt teaches a way for a wireless communication system to identify hot spots or dead spots. Referring to claim 1 of Schmitt cited by the Examiner, the Schmitt method determines a number of calls that have been dropped by the base station, determines an approximate location of each wireless station when its call was dropped, and interpolates the locations of each wireless station whose calls have been dropped to define a boundary for the region. All of these functions are performed by the wireless system itself. NONE OF THESE FUNCTIONS ARE PERFORMED BY A WIRELESS STATION. The steps in claim 26 include:

- (1) placing the portable phone in a dynamic region definition mode;
- (2) moving the portable phone to a first boundary point;
- (3) storing the first boundary point as a boundary point for the region as detected by the internal position detector;
- (4) repeating steps (2) and (3) until all desired boundary points have been entered; and
- (5) computing a region by connecting the boundary points.

While Schmitt does define a dead region where phone calls have been dropped, nowhere does Schmitt teach or suggest a definition of a region using a portable phone that performs the specific steps in claim 26. The Examiner has not addressed these individual steps 1-5 in claim 26. For this reason, the Examiner has failed to establish a prima facie case of obviousness for claim 26 under 35 U.S.C. §103(a).

Nowhere does Schmitt teach ANY of the limitations 1-5 in claim 26. The computation of a region in Schmitt is done by determining a location of a wireless station when a call is dropped. The dropping of a call is an unintended event. Nowhere does

Jonsson nor Schmitt teach or suggest the defining of a region using a portable phone as recited in claim 26.

In the Response to Arguments section of the pending office action, the Examiner states:

The “exact wording” is not the basis for novelty, it is the “system’s description and functionality” that warrants its novelty. Hence, Schmitt’s teaching of a method that can identify a region within a geographic coverage area of a BTS in a wireless network and interpolate the locations in said region to define a boundary reads on steps 1-5 and combines with Jonsson for a proper rejection.

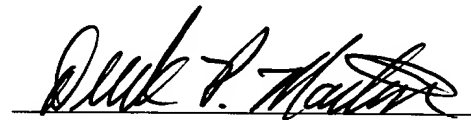
Wow. The Examiner’s language seems to imply that he can ignore the express claim limitations and instead look to the “description and functionality” that underlie the claim limitations. This rejection does not even pass the laugh test. For the Examiner to assert that he does not have to read the prior art on each and every claim limitation is ludicrous. How nice it would be if the PTO would provide proper training to their examining corps to avoid such misstatement of the proper standards for examining claims in a final rejection! Applicants’ attorney is not going to dignify the Examiner’s silly rejection with a detailed analysis. All that needs to be said is that the Examiner has failed to read the prior art on ANY of the five express limitations in claim 26. As a result, the Examiner has failed to establish a prima facie case of obviousness for claim 26 under 35 U.S.C. §103(a). The fact that the prior art defines a geographical region and the method in claim 26 defines a geographical region is not the issue. Claim 26 is directed to a specific method with the five steps expressly listed. NONE of these five steps are taught in either of the cited references. For this reason, claim 26 is clearly allowable over the combination of Jonsson and Schmitt. Applicants respectfully request that the Examiner’s rejection of claim 26 under 35 U.S.C. §103(a) be reversed.

CONCLUSION

Claims 1-22 and 26 are addressed in this Appeal. For the numerous reasons articulated above, applicants maintain that the rejection of claims 1-22 and 26 under 35 U.S.C. § 103(a) is erroneous.

Applicants respectfully submit that this Appeal Brief fully responds to, and successfully contravenes, every ground of rejection and respectfully requests that the final rejection be reversed and that all claims in the subject patent application be found allowable.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Derek P. Martin", written over a horizontal line.

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APPENDIX - CLAIMS FINALLY REJECTED

- 1 1. A telephone system comprising:
 - 2 a portable phone that includes a position detector that detects the position of the
 - 3 portable phone;
 - 4 a second phone; and
 - 5 a call router that automatically rings the second phone without requiring input
 - 6 from a user of the portable phone when a call is received for the portable phone if the
 - 7 portable phone is within a predetermined physical relationship with the second phone as
 - 8 indicated by the position detector in the portable phone.
- 1 2. The portable phone of claim 1 wherein the position detector comprises a global
- 2 positioning system (GPS) sensor.
- 1 3. The telephone system of claim 1 wherein the call router rings the portable phone at the
- 2 same time the call router rings the second phone, and connects the call to whichever of
- 3 the portable and second phones that is answered first.
- 1 4. The telephone system of claim 1 wherein the second phone comprises a portable
- 2 phone.
- 1 5. The telephone system of claim 1 wherein the second phone comprises a land-based
- 2 phone coupled to a telephone jack.
- 1 6. The telephone system of claim 1 wherein the predetermined physical relationship
- 2 comprises a predefined geographical region.
- 1 7. The telephone system of claim 1 wherein the predetermined physical relationship
- 2 comprises a predefined distance between the portable phone and the second phone.

1 8. The telephone system of claim 1 wherein the call router further rings the portable
2 phone when a call is received for the second phone if the portable phone is within the
3 predetermined physical relationship with the second phone.

1 9. The telephone system of claim 8 wherein the call router rings the portable phone at the
2 same time the call router rings the second phone, and connects the call to whichever of
3 the portable and second phones that is answered first.

- 1 10. A method for selectively ringing or not ringing a second phone when a call is placed
2 to a portable phone, the method comprising the steps of:
3 the portable phone using an internal position detector to detect its geographical
4 position; and
5 automatically ringing the second phone without requiring input from a user of the
6 portable phone when a call is received for the portable phone if the portable phone is
7 within a predetermined physical relationship with the second phone as indicated by the
8 internal position detector in the portable phone.
- 1 11. The method of claim 10 further comprising the steps of:
2 ringing the portable phone at the same time the second phone is rung; and
3 connecting the call to whichever of the portable and second phones that is
4 answered first.
- 1 12. The method of claim 10 wherein the second phone comprises a portable phone.
- 1 13. The method of claim 10 wherein the second phone comprises a land-based phone
2 coupled to a telephone jack.
- 1 14. The method of claim 10 wherein the predetermined physical relationship comprises a
2 predefined geographical region.
- 1 15. The method of claim 10 wherein the predetermined physical relationship comprises a
2 predefined distance between the portable phone and the second phone.
- 1 16. The method of claim 10 further comprising the step of ringing the portable phone
2 when a call is received for the second phone if the portable phone is within the
3 predetermined physical relationship with the second phone.

1 17. The method of claim 16 further comprising the steps of:
2 ringing the portable phone at the same time the second phone is rung; and
3 connecting the call to whichever of the portable and second phones that is
4 answered first.

1 18. A telephone system comprising:
2 (A) a portable phone that includes a position detector that detects the position of
3 the portable phone;
4 (B) at least one defined geographical region, each defined geographical region
5 having corresponding phone parameters that determine how a call is rung and routed;
6 (C) a mechanism that receives the position of the portable phone from the position
7 detector, and that determines from the position of the portable phone whether the portable
8 phone enters or exits a defined geographical region; and
9 (D) a call router that rings and routes a telephone call according to the phone
10 parameters for a region.

1 19. The telephone system of claim 18 wherein the position detector comprises a global
2 positioning system (GPS) sensor.

1 20. The telephone system of claim 18 wherein the at least one geographical region in (B)
2 and the mechanism in (C) reside within the portable phone, and the call router in (D)
3 resides in a telephone company network that is coupled to the portable phone.

1 21. The telephone system of claim 18 wherein the portable phone communicates its
2 detected position to the call router, and wherein the at least one geographical region in
3 (B), the mechanism in (C), and the call router in (D) reside in a telephone company
4 network that is coupled to the portable phone.

1 22. A method for selectively ringing or not ringing a second phone when a call is placed
2 to a portable phone, the method comprising the steps of:
3 the portable phone using an internal position detector to detect its geographical
4 position;
5 defining at least one geographical region;
6 defining phone parameters that determine how a call is rung and routed for each
7 defined geographical region;
8 receiving the position of the portable phone from the position detector;
9 determining from the received position of the portable phone whether the portable
10 phone enters or exits a defined geographical region;
11 updating phone parameters for a geographical region when the portable phone
12 enters the geographical region;
13 updating phone parameters for a geographical region when the portable phone
14 exits the geographical region; and
15 ringing and routing a telephone call according to the phone parameters for a
16 defined geographical region.

1 26. A method for dynamically defining a region for a portable phone that includes an
2 internal position detector, the method comprising the steps of:
3 (1) placing the portable phone in a dynamic region definition mode;
4 (2) moving the portable phone to a first boundary point;
5 (3) storing the first boundary point as a boundary point for the region as detected
6 by the internal position detector;
7 (4) repeating steps (2) and (3) until all desired boundary points have been entered;
8 and
9 (5) computing a region by connecting the boundary points.